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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,745	11/13/2003	Barrie P. Swain	7851	8904
22922	7590	01/28/2005	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA GABRIEL, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			SWIATEK, ROBERT P	
		ART UNIT		PAPER NUMBER
		3643		
DATE MAILED: 01/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

*✓*

### Office Action Summary

Application No.	10/712,745	Applicant(s)	SWAIN, BARRIE P.
Examiner	Robert P. Swiatek	Art Unit	3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 November 2004.  
2a) This action is FINAL.                            2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) 7-16 and 26-37 is/are allowed.  
6) Claim(s) 1-3, 5, 17, 18, 20-23, 38 and 39 is/are rejected.  
7) Claim(s) 4, 6, 19, 24, 25 is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 17, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Dersch (US 564,976: Ref. B on Information Disclosure Statement by Applicant). The Dersch saddletree includes an elongated spring element in the form of two overlying leather plies A, B and a curved strip segment C of rigid material secured by rivets to ply A. Although only two plies A, B are shown, page 1, lines 35-41, of Dersch notes the saddletree can be composed of more than two plies, with the plies increasing in length from the bottom of the saddletree (when in use) to the top. While the spring element perforce tapers in thickness from its center portion to its ends because of the differing lengths of the plies, lines 38-40 of Dersch state each individual ply also is reduced in thickness near its ends; together, the tapering and reduction in thickness permit progressive flexibility and minimal resiliency in response to flexure of the end portions so they “automatically adjust themselves to the back of any horse” (page 1, lines 47, 48, of Dersch). Inasmuch as the instant claims content themselves with merely reciting a “spring element” and do not set forth a specific numeric resiliency quotient or range, the Office contends the Dersch harness saddletree *does* have a minimal amount of inherent resiliency such that if one were to slightly separate the two branches of the saddletree and then release them, they would

spring back to assume their original angular orientation—exhibiting a bit of “memory” in the process. Thus they are slightly elastic in nature, although admittedly large of amounts of tension would permanently distort the saddletree and it would not return to its original shape, much less spring back with any large amount of force. As to claims 2, 17, if the Dersch saddletree is turned upside down, the plies increase in length from top to bottom. While no one seriously would consider using the Dersch saddletree in an inverted orientation (nor was this proposed by the Office), it is sufficient that simply inverting the Dersch saddle device enables it to then structurally “read upon” claims 2, 17. (In the latter scenario, the saddletree would rest on a floor or other horizontal support; alternatively, it could be held upside down by an individual.) With respect to claims 15, 23, the rivet-like elements d of Dersch securing strip segment C to ply A are considered to be pins.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dersch in view of Nankivell (US 3,712,024). The Dersch plies are constructed from leather, as noted above. The Nankivell saddletree—a one-piece, molded tree with an embedded horn—achieves strength and weather resistance through construction from polystyrene or nylon material (see column 1, lines 36-39, of Nankivell). It would have been obvious to one skilled in the art to construct the plies of Dersch from a nylon or thermoplastic material, in view of the

teaching of Nankivell that such material provides saddletree components with strength and weather resistance, eliminating many of the drawbacks of traditional materials.

Claims 38, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Dersch. If the Dersch saddletree is turned upside down, the plies overlap one another from smallest-length ply on top to longest-length ply at the bottom. While an inverted Dersch saddletree clearly would not work for its intended purpose, as a stationary object resting upon or supported above a surface, it anticipates claims 38, 39. Furthermore, as Dersch notes in column 1, lines 29-32, more than two plies can be secured together, one atop the next.

Claims 4, 6, 19, 24, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In claim 17, line 16, “overlaying” should be changed to –overlying–.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3643

Applicant's arguments filed 12 November 2004 have been fully considered but they are not persuasive. Claims 1-3, 5, 17, 18, 20-23, 38, 39 are not believed allowable for the reasons set forth above.

Summary: Claims 1-3, 5, 17, 18, 20-23, 38, 39 have been rejected; claims 4, 6, 19, 24, 25 have been objected to; claims 7-16, 26-37 have been allowed.

RPS: 0703/308-2700  
24 January 2005

*Robert P. Swiatek*

**ROBERT P. SWIATEK  
PRIMARY EXAMINER  
ART UNIT 323 3643**